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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,713	11/24/2003	Maria Schlesener	16356.835 (DC-05443)	5410
27683	7590	06/01/2005	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			EDWARDS, ANTHONY Q	
			ART UNIT	PAPER NUMBER
			2835	

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

EF

<b>Office Action Summary</b>	Application No. 10/720,713	Applicant(s) SCHLESENER ET AL.	
	Examiner Anthony Q. Edwards	Art Unit 2835	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-20 and 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 1-9 and 11 are objected to because of the following informalities: amended claim 1 recites the element "the locating receivers" at line 10, but the element is not mentioned until line 14. As such, there is insufficient antecedent basis for this limitation in the claim. Claims 2-9 and 11 depend, either directly or indirectly, from claim 1 and are therefore objected to for at least the same reasons. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 11-17 and 22-24 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,556,436 to Ohnishi. Referring to claims 1 and 12, Ohnishi discloses a vertical docking apparatus and information handling system (see Figs. 2, 2A and 2B) comprising a docking receiver member (30) having a docking surface (55), a guide member (not numbered) extending vertically from an edge of the docking surface (i.e., upstanding wall at rear of docking receiver member (30)), a plurality of elongated locating members (not numbered) extending vertically from the docking surface (i.e., pins positioned on both sides of connector (57)), a first connector (57) extending vertically from the docking surface, a plurality of locking members

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(72) mounted on the docking surface, a docking member (31) including a chassis (32), a microprocessor inherently located in the chassis and a storage inherently coupled to the microprocessor, the chassis (32) having a mating surface (40) for engagement with the docking surface (55), a plurality of locating receivers (not shown) on the mating surface inherently receiving the locating members (i.e., pins positioned on both sides of connector (57)), a second connector (35) extending vertically from the mating surface (40), and a plurality of locking member receivers (36) mounted on the mating surface, whereby primary engagement of the docking member with the guide member (i.e., back of 31 abuts upstanding wall of 30) and secondary engagement of the of the locating members with the locating receivers (i.e., pins with corresponding holes) aligns the first and second connectors for seating and for engagement of the locking members and the locking member receivers.

The Examiner has reason to believe that the functional limitation of “the elongated locating members engaging the locating receivers for maintaining the docking surface substantially parallel to the mating surface during a relative movement of the docking member and the docking receiver member” can be performed by the structure of Ohnishi (see Figs. 3, 3A and 3B), since the elongated locating members are shown as stationary elements (i.e., they do not rotate) and the mating surface of the docking member is substantially parallel to the docking surface docking receiver at all times (see Figs. 2 and 3). Since the Examiner has established a prima facie case, the burden shifts to the applicant to prove otherwise (See *In re Swinehart*, 169 USPQ 226 (CCPA 1971); *In re Schreiber*, 44 USPQ2D 1429 (Fed. Cir. 1997).

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Referring to claims 2 and 13, Ohnishi discloses a vertical docking apparatus and information handling system, wherein the docking receiver member (30) is a media slice (i.e., mobile docking station). See Fig. 2 and col. 8, lines 59-65.

Referring to claims 3 and 14, Ohnishi discloses a vertical docking apparatus and information handling system, wherein the docking member (31) is an information handling system. See Fig. 2 and col. 8, lines 11-19.

Referring to claims 4 and 15, Ohnishi discloses a vertical docking apparatus and information handling system, further comprising a plurality of ejection members (74) housed in the docking receiver member (30). See Figs. 9A-9L and the corresponding specification.

Referring to claims 5 and 16, Ohnishi discloses a vertical docking apparatus and information handling system, further comprising an ejection mechanism (73) located on the docking receiver member (30). See Figs. 9A-9L and the corresponding specification.

Referring to claims 6 and 17, Ohnishi discloses a vertical docking apparatus and information handling system, further comprising means (73) on the docking member receiver (*sic*) for disengaging the locking members (72) from the locking member receivers (36) and extending the ejection members (74) vertically from the docking surface (55).

Referring to claims 11 and 22, Ohnishi discloses a vertical docking apparatus and information handling system, further comprising means (73) on the docking member receiver (30) for locking the locking members (74) in the locking members receivers (36).

Referring to claims 23 and 24, the method steps are necessitated by the device structure as it is disclosed by Ohnishi.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 8, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohnishi in view of U.S. Patent No. 6,392,383 to Takimoto et al. Ohnishi discloses the invention as claimed, except for specifically teaching the docking receiver member including a cavity open to the docking surface, wherein a battery is provided in the cavity. Takimoto et al. disclose providing a docking station (see Figs. 7-11) for an information handling system with a cavity (180) housing a battery (103) therein.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide information handling system of Ohnishi with a cavity for housing a battery, as taught by Takimoto et al., since the device of Ohnishi would provide the system of Ohnishi with expanded battery life capabilities.

Claims 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohnishi in view of U.S. Patent No. 5,311,397 Harshberger et al. Ohnishi discloses the invention as claimed, except for at least one of the locking members being oriented to function in a first direction and at least one of the locking members is oriented to function in a second direction opposite the first direction. Harshberger et al. disclose providing a computer docking station (190) with locking members (220), wherein at least one locking member is oriented to function in a first direction (i.e., left to right) and at least one of the locking member is oriented to

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function in a second direction (i.e., right to left) opposite the first direction. See Figs. 1 and 11, as well as col. 7, lines 5-12.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide information handling system of Ohnishi with at least one of the locking members being oriented to function in a first direction and at least one of the locking members is oriented to function in a second direction opposite the first direction, as taught by Harshberger et al., since the device of Harshberger et al. would provide lateral support for the information handling system of Ohnishi in a simple manner.

#### *Response to Arguments*

Applicant's arguments filed March 3, 2005 have been fully considered but they are not persuasive. Referring to claims 1, 12 and 23, as indicated above, the Examiner has reason to believe that the functional limitation, included in the amended claims, can be performed by the prior art structure.

Furthermore, Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Q. Edwards whose telephone number is 571-272-2042. The examiner can normally be reached on M-F (7:30-3:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn D. Feild can be reached on 571-272-2800, ext. 35. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.




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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 26, 2005

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